

REMARKS/ARGUMENTS

Favorable consideration of this application in light of the following discussion is respectfully requested.

Claims 1-43 are pending.

In the Official Action, Claims 24-31 and 32-33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Baranowsky et al. (U.S. Patent No. 5,732,359, hereinafter Baranowsky) in view of Kaibo (Nikkei Communications, 10-19-1998, pp. 94-105, hereinafter Kaibo) and Bradley (U.S. Patent No. 5,995,041); and Claims 34-43 were allowed.

Applicants acknowledge with appreciation the indication of allowable subject matter.

Applicants acknowledge with appreciation the personal interview between the Examiner and Applicants' representative on November 4, 2005. During the interview, the Examiner acknowledged that the applied references fail to disclose or suggest Applicants' recited method of registering locations of separate mobiles (i.e., separate cellular and satellite mobiles). Because the applied references fail to disclose or suggest Applicants' recited method of registering locations of separate mobiles, the applied references inherently fail to disclose or suggest "retrieving the information for identifying the other mobile station, which is stored at the memory address for the corresponding position registration information *when an incoming call is undeliverable to the corresponding mobile station depending on the retrieved position registration information*; and delivering an incoming call to the other mobile station according to the retrieved identification information." The Examiner agreed to withdraw the outstanding rejection upon receipt of a formal response summarizing the arguments presented during the interview.

Briefly recapitulating, Claim 1 is directed to a mobile communication system connection control method. The mobile communication system includes a) a mobile station connected to a satellite-based system by radio, b) a mobile station connected to a ground-

based system by radio, and c) a public telephone network which sends an incoming request to the two mobile stations. The method includes 1) registering positions of the respective mobile stations in system groupings to which the respective mobile stations correspond; 2) storing information about the registration of a position of one mobile station at a memory address specified for the corresponding mobile station; 3) storing information for identifying the other mobile station at the specified memory address; 4) retrieving information about a position registration at a memory address specified for any of the mobile stations according to the incoming request sent from the public telephone network; 5) retrieving the information for identifying the other mobile station, which is stored at the memory address for the corresponding position registration information when an incoming call is undeliverable to the corresponding mobile station depending on the retrieved position registration information; and 6) delivering an incoming call to the other mobile station according to the retrieved identification information. Applicants' claimed method allows for routing calls incoming from a PSTN to either a) the mobile station connected to a satellite-based system by radio or b) the mobile station connected to a ground-based system by radio depending on the availability of either of these two separate mobiles.¹

Baranowsky describes a single mobile terminal apparatus that operates in both the cellular and satellite networks. That is, Baranowsky describes a dual mode terminal device. The terminal device has five different operating modes. It operates in a satellite only mode, a cellular only mode, an autoroam with satellite priority mode, an autoroam with cellular priority mode, and autoroam with cellular home location register (HLR) priority mode. The terminal apparatus monitors the cellular operation and satellite operation concomitantly.

¹ Figure 5, specification, page 21, line 5 – page 22, line 23.
See also, Figure 4, page 19, line 21 – page 21, line 4.

When a call is in progress in the cellular system, a seamless handoff may be effected to the satellite system.²

However, Baranowsky fails to disclose or suggest Applicants' recited method of registering locations of separate mobiles (i.e., separate cellular and satellite mobiles). Because Baranowsky fails to disclose or suggest Applicants' recited method of registering locations of separate mobiles, Baranowsky inherently fails to disclose or suggest "retrieving the information for identifying the other mobile station, which is stored at the memory address for the corresponding position registration information *when an incoming call is undeliverable to the corresponding mobile station depending on the retrieved position registration information*; and delivering an incoming call to the other mobile station according to the retrieved identification information." That is, because Baranowsky only discloses a single mobile phone, Baranowsky does not route an incoming call to a second of these separate mobiles when the first of these separate mobiles is unavailable.

Kaibo also describes a dual-mode terminal device. However, like Baranowsky, Kaibo fails to disclose or suggest Applicants' recited method of registering locations of separate mobiles (i.e., separate cellular and satellite mobiles) and routing an incoming call to a second of these separate mobiles when the first of these separate mobiles is unavailable.

Bradley describes a communications system which includes satellites and satellite phones communicating through the satellites directly. Figure 1 of Bradley shows portable satellite phones 102 and 104 communicating with a satellite network 100. The portable satellite phones 102 and 104 form antennae beams 106 and 108 that are directed toward satellites of the satellite network 100. The portable satellite phones 102 and 104 receive GPS signals 110 through GPS receivers included in the portable satellite phones 102 and 104. Satellites of the satellite network 100 may communicate with calling and call parties directly

² Baranowsky, abstract.

through the portable satellite phones or through a ground based communications network 200 to complete a communications path. Whether a called party is reached through either the portable satellite phone 102 or 104 or the ground based communications network 200 is determined by known methods such as specially assigned numbers. If a conventional telephone number is used, the ground based communications network 200 may connect to terminal 202 or to mobile unit 204 to reach the called party.³

Figure 14 of Bradley shows a process of communication using the portable satellite phone 102. In step S1016, the destination satellite establishes communication with a ground based communications network 200. Then the process goes to step S1018 where the ground based communications network connects the call to a terminal such as terminal 202 or mobile phone 204. In step S1020, the process waits for a predetermined amount of time for the called party to answer the call. If the called party answers the call then the process goes to step S1028 where the calling party and the called party are connected in a call. After the call is completed, the process ends at step S1038.⁴

However, like Baranowsky and Kaibo, Bradley fails to disclose or suggest “retrieving the information for identifying the other mobile station, which is stored at the memory address for the corresponding position registration information *when an incoming call is undeliverable to the corresponding mobile station depending on the retrieved position registration information*; and delivering an incoming call to the other mobile station according to the retrieved identification information.” That is, Bradley also fails to disclose routing calls to an alternate mobile network if an incoming call is undeliverable.

MPEP §706.02(j) notes that to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the

³ Bradley, Abstract; col. 2, lines 42-61.

⁴ Bradley col. 11, lines 18-30.

references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Also, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Without addressing the first two prongs of the test of obviousness, Applicants submit that the Official Action does not present a *prima facie* case of obviousness because both Baranowsky, Kaibo and Bradley fail to disclose all the features of Applicants' claimed invention.

Furthermore, Applicants submit there is no teaching, suggestion, or motivation, either explicitly or implicitly, in any of the cited references to combine the features cited in the Official Action to arrive at Applicants' inventions recited in Applicants' independent claims. Thus, Applicants submit it is only through an impermissible hindsight reconstruction of Applicants' invention that the rejection of Applicants' independent claims can be understood.⁵

⁵ MPEP § 2143.01 "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge of one of ordinary skill in the art."

Accordingly, in light of the previous discussion, Applicants respectfully submit that the present application is in condition for allowance and respectfully request an early and favorable action to that effect.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)



Eckhard H. Kuesters
Registration No. 28,870

Michael Monaco
Registration No. 52,041

EHK/MEMO/sjh

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